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Paper No. 11
RLS/kk

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re **bills.com, Inc.**

Serial No. 75/700,831

Anthony Benedetto of Billserv.com, Inc. for bills.com, Inc.

Martha Santomartino, Trademark Examining Attorney, Law
Office 112 (Janice O'Lear, Managing Attorney).

Before Simms, Hanak and Drost, Administrative Trademark
Judges.

Opinion by Simms, Administrative Trademark Judge:

Bills.com, Inc. (applicant), a Delaware corporation,
has appealed from the final refusal of the Trademark
Examining Attorney to register the mark BILLS.COM for
"dissemination of advertising for others via an on-line
electronic communications network," in Class 35, and
"financial services, namely, providing a website of
financial information, including bill presentment and

payment information and data," in Class 36.¹ The Examining Attorney has refused registration under Section 2(e)(1) of the Act, 15 USC §1052(e)(1), arguing that the asserted mark merely describes a characteristic or feature of applicant's services. Applicant and the Examining Attorney have submitted briefs but no oral hearing was requested.

We affirm in part and reverse in part.

Applicant's financial services provide a method for consumers to view and pay various bills. In the trade, this is known as EBPP -- Electronic Bill Presentment and Payment, according to applicant. The Examining Attorney argues that applicant is providing a service related to bills--a Web site where bill presentment and electronic payment information and data may be viewed. The subject matter of applicant's services, according to the Examining Attorney, is bills and bill paying. The Examining Attorney has noted applicant's own use of the word "bills" on applicant's Web site:

Bill Presentment & Payment Register Now

The great thing about using bills.com to pay your bills online is that the service is totally free for six months. You only have to register your payment

¹ Application Ser. No. 75/700,831, filed May 7, 1999, based upon applicant's allegation of a bona fide intention to use the mark in commerce. On November 13, 1999, applicant filed an amendment to allege use asserting first use of the mark and first use in commerce on July 26, 1999.

accounts and billers one time. From then on bill paying is as simple as clicking a few buttons.

Other benefits of using bills.com for online bill paying include:

- Elimination of paper billing
- Bill and Payment archival
- Reporting
- Payment scheduling
- Ability to view and pay bills anywhere/anytime

The Examining Attorney has also made of record third-party registrations which include disclaimers of the word "BILLS".

Applicant, on the other hand, argues that its asserted mark is only suggestive of its services because imagination and mental reasoning are required to identify the significance of the mark. Applicant notes that it provides other financial services as well, including the obtaining of stock quotes, mortgage rates, etc. Further, applicant contends that the word "bill" has more than one definition, and that those other meanings, such as a list of particulars, public notice, piece of paper money, and draft of proposed legislation, make the asserted mark suggestive of applicant's services. Applicant asks us to resolve any doubt in this matter in its favor.²

² Applicant has attached to its brief printouts of registrations owned by its parent company. In its brief, applicant asks that, in the event that the Board determines that this matter constitutes new evidence, we remand this case to the Examining

In response to applicant's arguments, the Examining Attorney states that the fact that a term may have different meanings in other contexts is not controlling because the determination we must make is on the basis of the mark as used on or in connection with applicant's goods or services. The Examining Attorney also contends that a term need not describe all of applicant's goods or services, but that it is sufficient if the term describes a significant attribute or feature of applicant's goods or services.

The determination of whether a mark is merely descriptive must be made, not in the abstract, but rather in relation to the goods or services for which registration is sought, the context in which the mark is used or intended to be used, in connection with the goods or services, and the possible significance which the mark may have to the average purchaser of the goods or services in the marketplace. *In re Omaha National Corp.*, 819 F.2d 1117, 2 USPQ2d 1859 (Fed. Cir. 1987) and *In re Abcor*

Attorney for consideration. Trademark Rule 2.142(d) provides that the record should be complete prior to the filing of an appeal and that the Board will ordinarily not consider additional evidence submitted after the appeal is filed. Applicant's request incorporated in its appeal brief is inappropriate. It is denied as untimely, because it should have been submitted prior to the submission of its appeal brief. However, even if we had considered this material, it would not change the result in this case.

Development Corp., 588 F.2d 811, 200 USPQ 215 (CCPA 1978).

A mark is merely descriptive if, as used in connection with the goods or services, it immediately conveys information about an ingredient, quality, characteristic, feature or function thereof or if it directly conveys information regarding the nature, function, purpose or use of the goods or services. *In re Abcor Development Corp.*, *supra*.

Upon careful consideration of this record and the arguments of the attorneys, we agree with the Examining Attorney that applicant's mark is merely descriptive of a significant aspect or feature of its Class 36 financial services. There is no question but that a central feature of applicant's financial services, as described in the application and as actually offered, is the ability to pay one's bills online. As such, the asserted mark BILLS.COM, consisting of the generic term "bills" and the top level domain (.com), which is a part of the address indicating that applicant is a commercial entity, merely describes applicant's online bill presentment and payment services.

We also note that applicant seeks registration of its mark for "dissemination of advertising for others via an on-line electronic communications network," in Class 35. Neither the Examining Attorney nor applicant has focused on

the question of mere descriptiveness of applicant's mark in connection with these advertising services. In the absence of evidence or even argument on this point, the Examining Attorney has not carried her burden of showing that BILLS.COM is merely descriptive of the dissemination of advertising for others in Class 35.

Decision: The refusal of registration for applicant's Class 35 services is reversed; the refusal of registration with respect to applicant's Class 36 services is affirmed.